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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,833	11/04/2003	Noriyuki Horiuchi	SN-US035134	5570
22919	7590	06/06/2005	EXAMINER	
SHINJYU GLOBAL IP COUNSELORS, LLP 1233 20TH STREET, NW, SUITE 700 WASHINGTON, DC 20036-2680				ROYAL, PAUL
ART UNIT		PAPER NUMBER		
		3611		

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/699,833	HORIUCHI, NORIYUKI	
	Examiner	Art Unit	
	Paul Royal	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 February 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 20-25 is/are allowed.
 6) Claim(s) 1-19 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 04 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/23/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 02/15/05 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 05/23/05 has been considered by the examiner.

Allowable Subject Matter

3. The indicated allowability of claims 13-19 is withdrawn in view of the newly discovered reference(s) to Cabeza (US 4,340,238), McCord, Jr. et al. (US 3,284,114), Chi (5,454,281) and Chi (US 5,331,864) as applied in the rejections based on the newly cited reference(s) which follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tison et al. Patent Application Publication 2003/0110880 A1).

Tison et al. teaches a head set spacer unit and steering assembly/expandable bicycle headset structure comprising:

a first tubular member (35) having a first free end, a first coupling end with a first mating adjustment structure (35a,35b,35c), and a first bore extending axially between the first free end and the first coupling end, the first bore having an innermost diameter that is sized to receive a steerer tube there-through; and

a second tubular member (35) having a second free end, a second coupling end with a second mating adjustment structure (35a, 35b,35c), and a second bore extending axially between the second free end and the second coupling end, the second bore having an inner diameter that is sized to receive the steerer tube there-through, the first and second mating adjustment structures being adjustably coupled together to change an effective overall axial length of the expandable bicycle headset structure,

the first and second tubular members (35, 35, respectively) being mounted between an upper steering bearing set (18) and a mounting portion (7) with the first and second tubular members (35, 35) being adjustably exposed when adjustably coupled such that an overall effective length of the first and second tubular members can be changed in an assembled state,

the innermost diameter of the first bore of the first tubular member being substantially identical to the innermost diameter of the second bore of the second tubular member,

wherein the first tubular member includes a flange/notch located at the first free end, the flange/notch having an outer peripheral surface with a pair of tool engagement surfaces, (see paragraph 0043, last sentence).

For claim 2, note the spacers/tubular members (35) contain counterbores (35a) and protrusions (35b) which are understood to be the same as engaging threads because the both counterbores/protrusions and threads present groves and extensions of the underlying component which combine to couple invention components together.

For claims 3-5 note the spacers/tubular members (35) can be arranged, for example by inverting the spacers/tubular members (35), as a locking member/threaded locking nut coupled to the first and second threads of other spacers/tubular members (35) and configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures, see paragraph 0043.

5. Claims 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by McCord, Jr. et al. (US 3,284,114).

McCord, Jr. et al teaches a telescoping pole comprising:
a first tubular member (26) having a first free end, a first coupling end with a first mating adjustment structure (threads), and a first bore extending axially between the first free end and the first coupling end, the first bore having an innermost diameter that is sized to receive a tube therethrough; and
a second tubular member (38) having a second free end, a second coupling end with a second mating adjustment structure (threads), and a second bore extending axially between the second free end and the second coupling end, the second bore having an inner diameter that is sized to receive the tube there-through, the first and

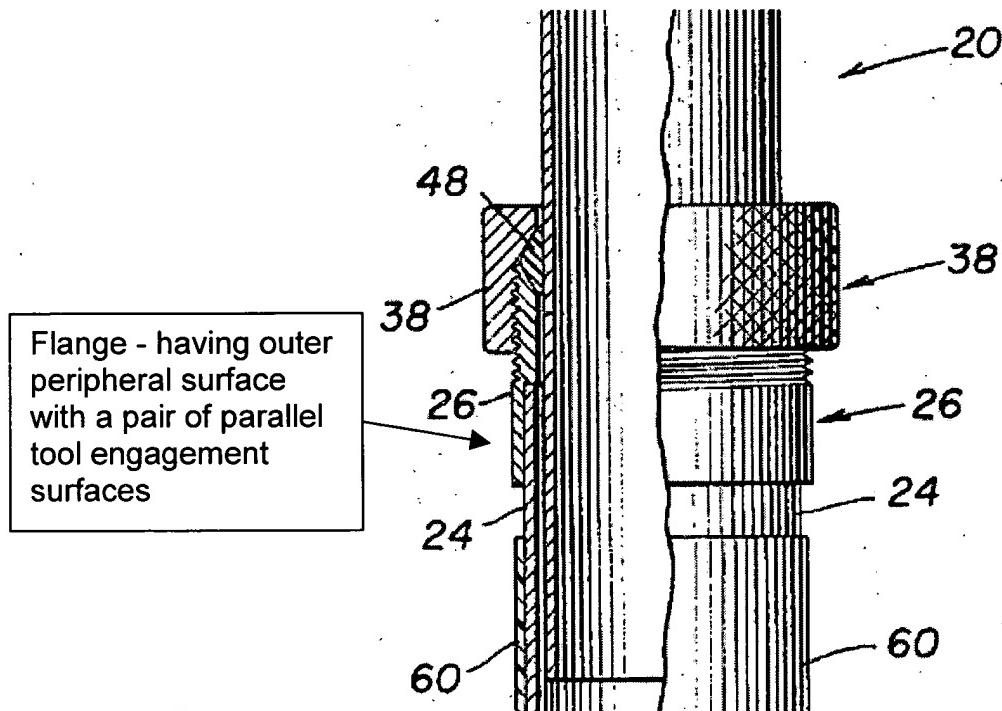
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second mating adjustment structures being adjustably coupled together to change an effective overall axial length of the telescoping pole,

the first and second tubular members (26,38) being adjustably exposed when adjustably coupled such that an overall effective length of the first and second tubular members can be changed in an assembled state,

the innermost diameter of the first bore of the first tubular member (26) being substantially identical to the innermost diameter of the second bore of the second tubular member (38),

wherein the first tubular member (26) includes a flange (see Examiner's annotated Figure 1) located at the first free end, the flange having an outer peripheral surface with a pair of tool engagement surfaces.



Note, the expandable bicycle headset structure presented by applicant is understood to be the same as the applied prior art of McCord, Jr. et al. where the only difference is the preamble of the instant application recites the invention is an "expandable headset structure" but does not recite any structural limitation not found in McCord, Jr. et al. This limitation in the preamble does not patentably distinguish the instant invention from the applied prior art because the applied prior art provides the same structure (i.e. telescoping pole sections) and the prior art solves the same adjustability problem of the instant application.

6. Claims 1-4, 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Cabeza (US 4,340,238).

Cabeza teaches a connection between a handlebar and steering fork including:
a first tubular member (12) having a first free end, a first coupling end with a first mating adjustment structure (threads), and a first bore extending axially between the first free end and the first coupling end, the first bore having an innermost diameter that is sized to receive a tube therethrough; and

a second tubular member (24) having a second free end, a second coupling end with a second mating adjustment structure (threads), and a second bore extending axially between the second free end and the second coupling end, the second bore having an inner diameter that is sized to receive the tube therethrough, the first and

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second mating adjustment structures being adjustably coupled together to change an effective overall axial length of the telescoping pole,

a locking member (30) configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures,

the locking member including a split locking collar having an adjustable inner diameter (the split allows the diameter to adjust) diameter, a first tapered surface (38) that engages the first tubular member (12), and a second tapered surface (34) that engages the second tubular member (24), the first and second tapered surfaces being configured and arranged to apply an axial force on the first and second tubular members,

the first and second tubular members (12,24) being adjustably exposed when adjustably coupled such that an overall effective length of the first and second tubular members can be changed in an assembled state,

wherein the first threads are external threads formed on an outer surface of the first tubular member (12), and the second threads are internal threads formed on an inner surface of the second bore of the second tubular member (24),

the innermost diameter of the first bore of the first tubular member (12) being substantially identical to the innermost diameter of the second bore of the second tubular member (24),

wherein the first tubular member (12) includes a flange (14) located at the first free end, the flange having an outer peripheral surface with a pair of tool engagement surfaces.

the first and second tubular members being mounted between an upper steering bearing set (bearing, see column 2, lines 25-27) and a mounting portion (8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCord, Jr. et al. (US 3,284,114) in view of Chi (5,454,281).

McCord, Jr. et al teaches a telescoping pole comprising:

a first tubular member (26) having a first free end, a first coupling end with a first mating adjustment structure (threads), and a first bore extending axially between the first free end and the first coupling end, the first bore having an innermost diameter that is sized to receive a tube therethrough; and

a second tubular member (38) having a second free end, a second coupling end with a second mating adjustment structure (threads), and a second bore extending axially between the second free end and the second coupling end, the second bore having an inner diameter that is sized to receive the tube therethrough, the first and second mating adjustment structures being adjustably coupled together to change an effective overall axial length of the telescoping pole,

a locking member (48) configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures,

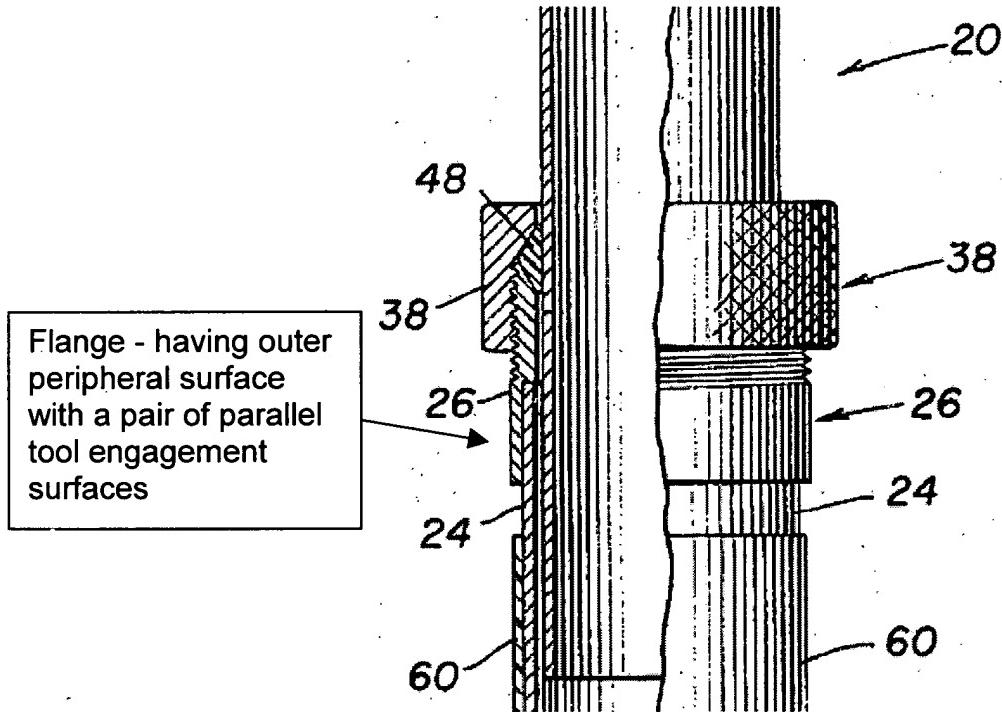
the locking member including a split locking collar having an adjustable inner diameter (the split allows the diameter to adjust) diameter, a first tapered surface (56) that engages the first tubular member (26), and a second tapered surface (54) that engages the second tubular member (38), the first and second tapered surfaces being configured and arranged to apply an axial force on the first and second tubular members,

the first and second tubular members (26,38) being adjustably exposed when adjustably coupled such that an overall effective length of the first and second tubular members can be changed in an assembled state,

wherein the first threads are external threads formed on an outer surface of the first tubular member (26), and the second threads are internal threads formed on an inner surface of the second bore of the second tubular member (38),

the innermost diameter of the first bore of the first tubular member (26) being substantially identical to the innermost diameter of the second bore of the second tubular member (38),

wherein the first tubular member (26) includes a flange (see Examiner's annotated Figure 1) located at the first free end, the flange having an outer peripheral surface with a pair of tool engagement surfaces.



McCord, Jr. et al. does not teach the first and second tubular members being mounted between an upper steering bearing set and a mounting portion.

Chi '281 teaches an upper steering assembly including first (10) and second (20) tubular members being mounted between an upper steering bearing set (33) and a mounting portion (50) to provide a steering assembly with minimized wearing and loosing on rugged roads when subjected to up and down shocks.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the telescoping pole mechanism of McCord, Jr. et al. with a steering assembly including first and second tubular members being mounted between an upper steering bearing set and a mounting portion, as taught by Chi '281 to provide a

steering assembly where the height of the headset is expandable which has minimized wearing and loosing on rugged roads when subjected to up and down shocks.

8. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Chi (US 5,331,864) in view of Chi (5,454,281).

Chi '864 teaches a connection between a handlebar and steering fork including:
a first tubular member (30) having a first free end, a first coupling end with a first mating adjustment structure (threads), and a first bore extending axially between the first free end and the first coupling end, the first bore having an innermost diameter that is sized to receive a tube therethrough; and

a second tubular member (26) having a second free end, a second coupling end with a second mating adjustment structure (threads), and a second bore extending axially between the second free end and the second coupling end, the second bore having an inner diameter that is sized to receive the tube therethrough, the first and second mating adjustment structures being adjustably coupled together to change an effective overall axial length of the telescoping pole,

a locking member (42) configured and arranged to be selectively set to prevent relative adjustment between the first and second mating adjustment structures,

the locking member including a split locking collar nut having an adjustable inner diameter (the split allows the diameter to adjust) diameter, and threadedly coupled to one of the first threads,

the first and second tubular members (30, 26) being adjustably exposed when adjustably coupled such that an overall effective length of the first and second tubular members can be changed in an assembled state,

wherein the first threads are external threads formed on an outer surface of the first tubular member (30), and the second threads are internal threads formed on an inner surface of the second bore of the second tubular member (26),

the innermost diameter of the first bore of the first tubular member (30) being substantially identical to the innermost diameter of the second bore of the second tubular member (26),

wherein the first tubular member (30) includes a flange (31) located at the first free end, the flange having an outer peripheral surface with a pair of tool engagement surfaces.

Chi '864 does not teach the first and second tubular members being mounted between an upper steering bearing set and a mounting portion.

Chi '281 teaches an upper steering assembly including first (10) and second (20) tubular members being mounted between an upper steering bearing set (33) and a mounting portion (50) to provide a steering assembly with minimized wearing and loosing on rugged roads when subjected to up and down shocks.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the telescoping pole mechanism of Chi '864 with a steering assembly including first and second tubular members being mounted between an upper steering bearing set and a mounting portion, as taught by Chi '281 to provide a steering

assembly where the height of the headset is expandable which has minimized wearing and loosing on rugged roads when subjected to up and down shocks.

Note, with respect to claim 7, the difference between the inner most diameter of the first bore and the inner most diameter of the second bore is merely the width of the perimeter wall (including the width of the threads) and is understood to be relative insubstantial and therefor the bore diameter are understood to be substantially identical.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lin teaches a bicycle front fork mounting structure.

Allowable Subject Matter

10. Claims 20-25 are allowed.

The following is an examiner's statement of reasons for allowance:
For claims 20-25, the prior art does not show an expandable headset structure as recited in the independent claim and as applicable to the dependent claims which includes a bicycle component having an operator using portion with an outermost width larger than the first bore of the first tubular member and a steerer tube insertion portion as recited.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Royal whose telephone number is 571-272-6652. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P. Royal
5/31/05

Paul Royal
Examiner
Art Unit 3611

Lesley D. Morris
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SUPERVISORY PATENT EXAMINER
PHYSIOLOGY CENTER 3600